

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

OCTOBER 2003

SUBJECT GROUP F

Patent Systems

Time Allowed : 4 hours

Instructions to Candidates

- * Standard required to pass: 50%
- * Reading Time: 10 minutes
- * Candidates should attempt ALL questions
- * The maximum marks for each question are indicated at the end of the question

Question 1

Your Associate writes to you querying the implications of requesting modified examination in Australia as opposed to normal examination. Write a letter in reply.

(10 marks)

Question 2

Write a letter to your Australian client who has a thriving start up business but no experience with patents and patent terminology comparing and contrasting the following key aspects of US and EU patent law:

Right to file

Novelty

Inventive step

Invalidation procedures

Speed to grant

Relative costs

The comments may be in a tabulated form. Do not use patent attorney jargon if at all possible.

(12 marks)

Question 3

Your US Associate writes to you as follows:

"You have in your care our client's Australian patent application 200102345 which entered National Phase, according to your firm's advice, on 25 May 2003. The priority application was filed in the USA on 25 November 2000.

Our client has identified an Australian organisation which they believe may potentially infringe the patent which will be granted on this application. We understand that in a court action, infringement may be found based on any activity that took place after publication. The international publication date on the case is 25 May 2002. Can you please elaborate on when publication occurs in Australia with a view to the possibility that our client may wish to take an infringement action based on the patent ultimately granted.

We have become aware of this potential infringer because they have approached our client. They have forwarded a copy of an advertisement which appeared in the Australian Newspaper on 27 May 2002 in which they sought expressions of interest to manufacture the product the subject of this patent application. The infringer is, we understand, a large public hospital. They have offered what our client considers an unacceptably low royalty rate, hence our investigation of our options concerning any infringement options."

You interrogate the records of the Australian Patent Office and find that the OPI date recorded is 29 May 2002.

Advise your client.

(12 marks)

Question 4

You act on behalf of an Australian spin-out company whose directors were previously employed researchers at a large public research organisation. While they were still at the public research organisation, an international application at first instance was lodged at IP Australia with the public research organisation and their collaboration partners, a Taiwanese company, as co-applicants. The public research organisation has since assigned their rights in the international application to the spin-out company, StartUp Pty Ltd.

The directors of StartUp Pty Ltd have now had a major dispute with their Taiwanese collaborators and wish to withdraw completely from the project. They propose to wind up StartUp Pty Ltd and transfer their rights in the project to the Taiwanese company.

You have today received a facsimile from the Taiwanese company advising that they wish you to continue to act on their behalf. They note that, in their view, the claim set is incomplete, and that for certain examples in the description, there should also be claims in the application. They also comment that they now require three more designations; in the USA, Argentina and Mexico.

You have also received an internal note from your filing clerk who notes that, on reviewing the file, she has observed that the copy of the Request that she has on file is signed by you with the implication that the one she has lodged at the Receiving Office is unsigned. There was also no abstract lodged with the application.

Write a letter to the Taiwanese company setting out what they, and you, need to do to maintain their intellectual property protection, and any time limits that apply.

(16 marks)

Question 5

Your client is a large Australian Research organisation which has developed over an 18 month period an invention which they believe will have little commercial relevance here in Australia, but will be very saleable in France, Germany, the UK and the United States. In a state of the art search they have identified a US based organisation which has a significant number of publications in the scientific literature in the last year directed to technology that overlaps with their own. Amongst the publications they can identify a focus on the same problem which their own technology seeks to address, although the solutions identified are not on all fours with your client's solution. One of the client's researchers was at a forum in the US six months ago at which the US researcher was demonstrating their technology. Your client is keen to get the premier patent position in relation to their inventive technology with a view to ensuring that they trump the competitive US organisation, and prevent them from getting a patent position on the same technology.

Advise your client of a suitable patent filing strategy over the next three years, explaining any alternatives, and the reasons for your recommendations.

(16 marks)

Question 6

A number of years ago, you handled the filing and prosecution of a standard patent application directed to a new improved rotary cheese grater for a local client who specializes in kitchenware, and has a very successful franchise operation through which he distributes and sells his products throughout Australia. His patent is now about 12 years old by your recollection when he rings you to tell you of an improvement he has made to the mechanism of the cheese grater due to increasing competition in this area from international competitors. The trouble is, he tells you, the improvement he has made certainly improves the product because it will be much better at grating soft foodstuffs such as soft cheeses, but mechanically it is a relatively straight forward variation, albeit one he hasn't seen before. He does envisage a situation wherein he might need to exercise his rights in his technology against these international competitors, but margins in kitchenware are not huge

and he would like to ensure that he is spending his money in the best way possible. He sees no urgency in getting his protection for the variation, but agrees that a degree of certainty is always attractive.

Advise your client of the options he has available for protecting his new technology and your recommendation as to the best way to proceed.

(10 marks)

Question 7

a) Discuss what is meant by the term "presumption of validity" and place in order of increasing presumption of validity, patents granted in New Zealand, Japan, South Africa and the United States with brief reasons for the order.

(4 marks)

b) A local client has heard about "section 27 notifications" and wants to know of their pros and cons. Their competitor filed a patent application about which they are concerned 6 months ago.

(3 marks)

c) Write a disclaimer that might be part of a search report prepared by you pursuant to a request for an international keyword novelty search of an electronic database.

(5 marks)

Question 8

Your Australian client filed a PCT application on 28 May 2002 claiming priority of 1 June 2001. He advises he intends to instruct you to commence the national phase in New Zealand by filing a patent application there.

You have previously advised him that there is more than one invention present in the specification and he has indicated that protection for each will be required in due course, but, that he will not be able to fund that for some time yet.

He asks for a full explanation of the process of obtaining a New Zealand patent, and of the time limits which apply for all steps in the process.

Advise your client, and include the steps which can be taken to accommodate his stated position.

(12 marks)